



IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Serial No. : 09/842,347
Applicants : Tohru TAKAHASHI et al.
Filed : April 25, 2001
For : EXPRESSION SYSTEM
UTILIZING AUTOLYZING
FUSION PROTEINS AND A
NOVEL REDUCING POLYPEPTIDE
Art Unit : 1652
Examiner : Fronda
Docket No. : 950376D1/HG
Customer No.: 01933
Confirmation No.: 7829
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR FULLY INITIALED
COPY OF FORM PTO-1449**

S I R :

The Office Action mailed October 15, 2003 (Paper No. 10) enclosed a copy of the Form PTO-1449 dated April 25, 2001 with the Examiner's initials next to all the cited publications, except for EP 321,973 and the Boye et al. publication. A line was drawn through the citation of EP 321,973. No reason was given why EP 321,973 was not considered.

It is noted that EP 321,973 (which is German) was cited in the European Search Report (in English) that was enclosed with the April 25, 2001 INFORMATION DISCLOSURE STATEMENT. Moreover, on the enclosed copy of the Form PTO-1449, it was indicated that USP 5,149,783 is a related family member of EP 321,973.

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OCT 31 2003

TECH CENTER 1600/2900

CERTIFICATE OF MAILING

I hereby certify this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class mail in an envelope addressed to:
Commissioner for Patents,
P.O. Box 1450
Alexandria, VA 22313-1450
on the date noted below.

Attorney: Richard S. Barth

Dated: October 23, 2003


In the event that this Paper is late filed, and the necessary petition for extension of time is not filed concurrently herewith, please consider this as a Petition for the requisite extension of time, and to the extent not tendered by check attached hereto, authorization to charge the extension fee, or any other fee required in connection with this Paper, to Account No. 06-1378.

For the reasons set forth on page 600-122 of MPEP under the heading "Concise Explanation of Relevance for Non-English Language Information", a copy of which is enclosed, EP 321,973 should be considered and made of record.

The Examiner is therefore respectfully requested to return a copy of sheet 1 of the Form PTO-1449 dated April 25, 2001 (a copy of which is enclosed) with the Examiner's initials in the left column next to each cited publication to indicate that all of the cited publications were considered and made of record.

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Respectfully submitted,


Richard S. Barth
Reg. No. 28,180

Encs. (1) Copy of Form PTO-1449 dated April 25, 2001
(2) Copy of page 600-122 of the MPEP

Second, 37 CFR 1.98(c) states that when the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. The examiner will then consider only the patent or publication of which a copy is submitted and will so indicate on the list, form PTO-1449, or PTO/SB/08A and 08B, submitted, e.g., by crossing out the listing of the cumulative information. But see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1374, 54 USPQ2d 1001, 1005 (Fed. Cir. 2000) (Reference was not cumulative since it contained a more complete combination of the claimed elements than any other reference before the examiner. "A withheld reference may be highly material when it discloses a more complete combination of relevant features, even if those features are before the patent examiner in other references." (citations omitted)).

37 CFR 1.98(a)(3)(ii) states that if a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in 37 CFR 1.56(c), a copy of the translation shall accompany the statement. Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. If no translation is submitted, the examiner will consider the information in view of the concise explanation and insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches.

A (3) Concise Explanation of Relevance for Non-English Language Information

Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in

37 CFR 1.56(c) most knowledgeable about the content of the information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein with the page(s) and lines of the specification where it is incorporated being noted in the IDS.

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a complete translation of the information into English is submitted with the non-English language information, no concise explanation is required. An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information disclosure statement. There is no requirement for the translation to be verified. Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report. The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a United States application which is not relied on under 35 U.S.C. 120.

If information cited or submitted in a prior application relied on under 35 U.S.C. 120 was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application.



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SHEET 1 of 2

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INFORMATION DISCLOSURE
STATEMENT BY APPLICANT
PTO - 1449

ATTORNEY DOCKET NO. 950376D1/HG

SERIAL NO.
Div. Appl. of
09/167,151

APPLICANT: Tohru TAKAHASHI et al.

FILED: Concomitantly Herewith

ART UNIT:

U.S. PATENT DOCUMENTS

DOCUMENT NUMBER	DATE	NAME	CLASS	SUB	
5,162,601 5,149,783 6,077,694	11-1992 9-1992 6-2000	Slightom Sommergruber et al Medabalimi			

FOREIGN PATENT DOCUMENTS

DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB	TRANSLATION	
					YES	NO
WO 93/05071 EP 321,973 WO 95/21249 X* Related family member of USP 5,149,783	3-1993 6-1989 8-1995	WIPO Europe WIPO			X*	

OTHER DOCUMENTS (AUTHOR, TITLE, DATE, PAGES, PUBLICATION, ETC.)

K. Boye et al., Plant Molecular Biology, 18, 1203-1205, 1992, "cDNA cloning and sequencing of the bean yellow mosaic virus nuclear inclusion protein genes".

EXAMINER:

DATE CONSIDERED:

April 25, 2001